



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,065	12/29/2000	Emilio Alberti	YOR920000593	7741
7590 Blanche E. Schiller, Esq. HESLIN & ROTHENBERG, P.C. 5 Columbia Circle Albany, NY 12203			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3600	PAPER NUMBER
			MAIL DATE 03/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EMILIO ALBERTI, WALTER BAUR, and ROGER KERR

Appeal 2007-3317
Application 09/752,065
Technology Center 3600

Decided: March 10, 2008

Before LINDA E. HORNER, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

HORNER, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE

Emilio Alberti et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-8, 10-33, 35-60, and 62-76, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is to a method of managing information within a public electronic environment, wherein one or more aspects of managing the information traditionally performed within a private electronic environment are performed within the public electronic environment off-line from the private electronic environment (Specification 2:22 – 3:5). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method of managing information, said method comprising:

identifying information, via a public electronic environment, from an enterprise resource planning system within a private electronic environment;

managing the information using the public electronic environment, wherein one or more aspects of managing the information are performed within the public electronic environment off-line from the private electronic environment; and

registering the managed information, via the public electronic environment, with the private electronic environment.

THE REJECTIONS

The Examiner relies upon the following evidence:

Walker	US 5,794,207	Aug. 11, 1998
--------	--------------	---------------

The following rejections are before us for review:

1. Claims 1-8, 10-23, 25-33, 35-48, 50-60, 62-74, and 76 are rejected under 35 U.S.C. § 102(b) as being anticipated by Walker.
2. Claims 24, 49, and 75 are rejected under 35 U.S.C. § 103(a) as unpatentable over Walker.

ISSUE

The Appellants contend that the system of Walker is operated entirely in a public network, and thus Walker fails to teach or suggest a private electronic environment (App. Br. 9, 14).

The Examiner found Walker's central controller 200 maintains information within a private electronic environment because buyers and sellers can only access limited information stored at the central controller and/or only certified sellers can browse and bind the conditional purchase orders (Ans. 7-8).

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting the claims as anticipated by or obvious in view of Walker. This issue turns on whether Walker teaches or suggests the claimed private electronic environment.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The ordinary and customary meaning of “private” is 1a. Secluded from the sight, presence, or intrusion of others: *a private hideaway*. b. Designed or intended for one's exclusive use: *a private room*. 2a. Of or confined to the individual; personal: *a private joke; private opinions*. b. Undertaken on an individual basis: *private studies; private research*. c. Of, relating to, or receiving special hospital services and privileges: *a private patient*. 3. Not available for public use, control, or participation: *a private club; a private party*. *The American Heritage Dictionary of the English Language* (4th ed. 2000), found at www.bartelby.com.
2. The ordinary and customary meaning of “electronic” within the computer science context is of, implemented on, or controlled by a computer or computer network. *Id.*
3. The ordinary and customary meaning of “environment” within the computer science context is a. The entire set of conditions under which one operates a computer, as it relates to the hardware, operating platform, or operating system. b. An area of a computer's

memory used by the operating system and some programs to store certain variables to which they need frequent access. *Id.*

4. Thus, considering these definitions in combination, the ordinary and customary meaning of the phrase “private electronic environment” is the condition under which one operates a computer or computer system such that the computer or computer system is not available for public use, control, or participation.
5. The Appellants’ Specification does not provide a definition of the phrase “private electronic environment.”
6. The ordinary and customary meaning of the phrase “private electronic environment” is consistent with the Appellants’ use of the phrase in the Specification.
7. For example, the Appellants’ Specification provides an example of a private electronic environment as “a server internal to a corporation” (Specification 6:23-24).
8. The Specification further describes in an embodiment that the “[p]rivate electronic environment 102 includes a back-end system 112 having, for instance, one or more servers 114” (Specification 7:6-8).
9. The Specification also distinguishes between public and private electronic environments, describing a messaging manager 204 that is located on a public server 110 and “used in communicating

- between public server 110 and server 114 of the private environment (i.e., the private server)” (Specification 8:20-23).
10. The Specification further distinguishes between public and private electronic environments by referring to the public environment as the “front-end” of the system and the private environment as the “back-end” of the system (Specification 14:3-15).
 11. The Specification describes that the “front-end” of the system, i.e., the public electronic environment, includes a web browser 108 and a web server 110 (Specification 7:1-25 and 20:19-21).
 12. Walker discloses an electronic network and central controller 200 through which communications between buyers and sellers are conducted for completing a transaction (Walker, col. 8, ll. 42-44).
 13. Walker discloses a buyer interface 400 and seller interfaces 300 that each access central controller 200 “via an Internet connection using a public switched phone network” or via dedicated data lines, cellular, Personal Communication Systems, microwave, or satellite networks (Walker, col. 11, ll. 53-63; Fig. 1).
 14. Walker’s central controller 200 contains databases in a data storage device 250 that include all information necessary to complete the transaction (Walker, col. 12, ll. 54-67; Fig. 2).
 15. Walker discloses that in one embodiment, the functionality of the central controller 200 is divided into three components embodied

on separate servers: an operations server, a trusted server, and a bonding agency (Walker, col. 10, ll. 8-16; Fig. 20).

16. Walker describes that these servers work in conjunction with buyer interface 400 and seller interface 300, and that “[t]his separation [of central controller 200 into three servers] makes it more difficult for attackers to compromise the system, as they must defeat the security of three separate systems instead of one” (Walker, col. 27, ll. 24-29).
17. These three servers, however, are each directly accessible to the public and available for public use from the seller interface 300 and buyer interface 400 (see e.g., Walker, Fig. 20).
18. As such, Walker does not disclose a private electronic environment as recited in the claims.
19. Rather, Walker’s central controller 200 is a secure public electronic environment, meaning that it is available for direct access by the public, but it is secure because it restricts the scope of access (e.g., by use of cryptographic keys) (see e.g., Walker, col. 23, l. 64 – col. 26, l. 53).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior

art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

ANALYSIS

The issue in this case centers on the meaning of “private electronic environment” as that term is used in each of the pending claims. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims “their broadest reasonable interpretation consistent with the specification” and “in light of the specification as it would be interpreted by one of ordinary skill in the

art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). *See also In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

The ordinary and customary meaning of “private” is not available for public use, control, or participation (FF 1). The ordinary and customary meaning of “electronic” within the computer science context is of, implemented on, or controlled by a computer or computer network (FF 2). The ordinary and customary meaning of “environment” within the computer science context is the entire set of conditions under which one operates a computer, as it relates to the hardware, operating platform, or operating system (FF 3). Thus, the ordinary and customary meaning of “private electronic environment” is the condition under which one operates a computer or computer system such that the computer or computer system is not available for public use, control, or participation (FF 4).

Although the Appellants’ Specification does not provide a definition of the phrase “private electronic environment” (FF 5), the ordinary and customary meaning of the phrase, as we have defined it, is consistent with the Appellants’ use of the phrase in the Specification (FF 6-11). In particular, the Specification describes the private electronic environment as a server. For instance, the Appellants’ Specification provides an example of a private electronic environment as “a server internal to a corporation” (FF 7), and describes that in order to access this server in the back-end system, one must communicate through a public server 110 in the front-end system (FF 8-11). Thus, we construe “private electronic environment” to mean the

condition under which one operates a computer or computer system such that the computer or computer system is not available for public use, control, or participation. In other words, the Appellants' claimed private electronic environment is not directly accessible to the public. Rather, the information contained in the private electronic environment is accessible to the public only via the claimed public electronic environment (e.g., a public server).

Walker discloses an electronic network and central controller 200 containing databases in a data storage device 250 which are directly accessible to the public (i.e., buyers and sellers) via the Internet (FF 12-14). Walker discloses that in one embodiment, the functionality of the central controller 200 is divided into three components embodied on separate servers, which work in conjunction with buyer interface 400 and seller interface 300 and are directly publicly accessible by buyers and sellers (FF 15-17). As such, Walker does not disclose a private electronic environment as recited in the claims (FF 18).

The Examiner asserts that Walker's central controller 200 is a private electronic environment "because buyers and sellers can only access limited information stored at the central controller ('207, figure 2) and/or only certified (i.e., authenticated cryptographically or otherwise) sellers can browse and bind the CPOs ('207, column/line 23/64-24/23; column 29, lines 5-16)" (Ans. 7-8). This statement by the Examiner acknowledges that the central controller 200 of Walker allows direct access to the controller by buyers and sellers (e.g. members of the public), once the buyers and sellers

are certified. As such, Walker's central controller 200 is a secure public electronic environment, meaning that it is available for direct access by the public, but it is secure because it restricts the scope of access (e.g., by use of cryptographic keys) (FF 19). Because Walker's central controller 200 is accessible directly by the public, it is not a private electronic environment as we understand that term to be used in the claims. In other words, Walker's system does not have a server located between the buyer/seller interfaces (e.g., browsers) and the central computer 200 that prevents direct access to the central computer by the public. As such, Walker does not teach or suggest the claimed private electronic environment, and thus does not anticipate the subject matter of claims 1-8, 10-23, 25-33, 35-48, 50-60, 62-74, and 76, nor does it render obvious the subject matter of claims 24, 49, and 75.

CONCLUSIONS OF LAW

We conclude the Appellants have shown that the Examiner erred in rejecting claims 1-8, 10-23, 25-33, 35-48, 50-60, 62-74, and 76 under 35 U.S.C. § 102(b) as anticipated by Walker, and claims 24, 49, and 75 under 35 U.S.C. § 103(a) as unpatentable over Walker.

Appeal 2007-3317
Application 09/752,065

DECISION

The decision of the Examiner to reject claims 1-8, 10-33, 35-60, and 62-76 is reversed.

REVERSED

vsh

BLANCHE E. SCHILLER, ESQ.
HESLIN & ROTHENBERG, P.C.
5 COLUMBIA CIRCLE
ALBANY NY 12203